

Application No. 10/706,715  
Amendment dated March 27, 2008  
Reply to Office Action of December 12, 2007

### **REMARKS**

Applicant amended independent claims 1 and 12 to further define Applicant's invention.

In the Office Action, the Examiner has rejected various claims (including independent claims 1 and 12) under 35 U.S.C. § 102(b) based on the following: claims 1, 3-10, and 27-30 were rejected as being anticipated by U.S. Patent No. 4,777,949 to Perlin ("Perlin"); claims 1, 12, 14, 27, 28, 31, and 32 were rejected as being anticipated by U.S. Patent No. 1,666,514 to Sigler ("Sigler"); claims 1, 3, 4-7, 10, 12, 13, 15-20, 23, 28, 29, 32, and 33 were rejected as being anticipated by U.S. Patent No. 4,777,950 to Kees, Jr. ("Kees"); claims 1, 3-7, 12, 13, 15-20, 28, and 32 were rejected as being anticipated by U.S. Patent No. 3,125,789 to Parker ("Parker"); and claims 1, 3-9, 12, 13, 16-22, 28, 29, 32, and 33 were rejected as being anticipated by U.S. Patent No. 2,113,991 to Larsen ("Larsen"). In doing so, it appears that the Examiner has maintained the rejections of independent claims 1 and 12 under 35 U.S.C. § 102(b) from the previous Office Action of May 4, 2007.

According to the MPEP § 706.02, "for anticipation under 35 U.S.C. 102, the [prior art] reference must teach every aspect of the claimed invention either explicitly or impliedly." Furthermore, according to MPEP § 2111.01, "[d]uring examination, the claims must be interpreted as broadly as their terms reasonably allow." However, MPEP § 2111.01 couches such guidance regarding claim interpretation in the "plain meaning" of the claim terms. According to MPEP § 2111.01, "this [i.e., broadly interpreting the claim terms] means that the words of the claims must be given their plain meaning unless the plain meaning is inconsistent with the specification."

As discussed below, Applicant submits that the Examiner has not "reasonably" construed the claim terms "proximal," "proximate," and "end." In interpreting these terms of independent claims 1 and 12 broadly, the Examiner has ignored the "plain meaning" thereof. In fact, Applicant submits that the Examiner has read these claim

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terms so broadly so as to devoid them of any meaning, let along their "plain meaning." As discussed below, if the claim terms "proximal," "proximate," and "end" are properly interpreted, Applicant submits that the Examiner's rejections of independent claims 1 and 12 under 35 U.S.C. § 102(b) cannot be maintained.

In maintaining the rejection of independent claims 1 and 12 under 35 U.S.C. § 102(b) based on Perlin, Fig. 2 thereof is used to show that the Examiner considers that an entire half of a surgical clip (20) is considered the proximal end. Furthermore, the Examiner indicates that similar reasoning is applied in maintaining the independent claims 1 and 12 under 35 U.S.C. § 102(b) based on Sigler and Kees. According to the Examiner, "the entire proximal half of the [devices of Sigler and Kees] can be considered the proximal end."

By considering the "entire proximal half" of the devices of Perlin, Sigler, and Kees the "proximal end", the Examiner can indicate that ends (42) and (52) of jaws (36) and (46), respectively, of the surgical clip (20) of Perlin terminate at the "proximal end" (even though the ends (42) and (52) terminate adjacent the middle of the surgical clip (20)); can indicate that both ends of a single piece of wire forming a paper clip of Sigler terminate at the "proximal end" (even though at least one of the ends of the single piece of wire terminates adjacent the middle of the paper clip); and can indicate that ends (30) and (32) of a vascular clip (10) of Kees terminate at the "proximal end" (even though the ends (30) and (32) terminate adjacent the middle of the vascular clip (10)).

However, Applicant submits that independent claims 1 and 12 do not recite that the proximal end of the surgical ligation clip includes an entire half thereof, or that the first free end and the second free end terminate adjacent the middle of the surgical ligation clip. Instead, independent claims 1 and 12 recite a surgical ligation clip having a distal end, a proximal end opposite the distal end, where the first free end and the second free end of the wire forming the surgical ligation clip terminate proximate the proximal end. Moreover, the plain meanings of the claim terms "proximal," "proximate," and "end" as evidenced by their definitions from Dictionary.com are "situated toward the

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point of origin or attachment," "close; very near," and "a part or place at or adjacent to an extremity," respectively. Accordingly, it is apparent that if these claim terms are properly interpreted, neither Perlin, Sigler, nor Kees teach or suggest a surgical ligation clip formed of a single piece of material having a first free end and a second free end terminating proximate the proximal end thereof as recited in independent claims 1 and 12. As such, Applicant submits that independent claims 1 and 12 are patentable over the Examiner's rejection under 35 U.S.C. § 102(b) based on Perlin, Sigler, and Kees.

Additionally, independent claims 1 and 12, as amended, overcome the Examiner's rejections under 35 U.S.C. § 102(b) based on Parker and Larson. As discussed in Applicant's Response dated September 14, 2007, the spring clip of Parker includes a coil (10) and opposite legs (11) extending therefrom. Opposite the coil (10), one of the opposite legs (11) includes a bend (20), and the other of the opposite legs (11) includes a bend (28). As shown in Fig. 1, the width of the opposite legs (11) at the bends (20) and (28) is less than the width of the coil (10). Furthermore, as discussed in Applicant's Amendment dated September 14, 2007, the clothespin of Larson includes a coil (1) and jaws (3) extending therefrom. As shown in Fig. 2, the width of the jaws (3) adjacent the ends thereof opposite the coil (1) appear equal to (if not less than) the width of the coil (1).

Accordingly, neither Parker nor Larson teach or suggest the surgical ligation clip recited in amended independent claims 1 and 12. Neither the coil (10) of Parker nor the coil (1) of Larson has "a maximum width perpendicular to the mid-longitudinal axis in a first plane generally parallel to the mid-longitudinal axis,...wherein adjacent said distal end of said clip at least one of said upper support member and said lower support member has a width perpendicular to the mid-longitudinal axis in a second plane generally parallel to the first plane greater than said maximum width of said connector," as recited in amended independent claims 1 and 12. As such, Applicant submits that independent claims 1 and 12, as amended, are patentable over the Examiner's rejection under 35 U.S.C. § 102(b) based on Parker and Larson.

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Additionally, the Examiner rejected claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Perlin in view of U.S. Patent No. 5,593,414; rejected claims 11 and 24 as being unpatentable over Kees in view of U.S. Patent No. 5,858,018; and rejected claims 12 and 32-34 as being unpatentable over Perlin in view of Kees. Applicant submits that the Examiner's rejections of claims 2 and 11 are rendered moot at least because these claims depend from allowable independent claim 1.

Regarding the Examiner's rejection of independent claim 12 under 35 U.S.C. § 103(a) based on Perlin in view of Kees, Applicant again submits that, if the claim terms "proximal," "proximate," and "end" are properly interpreted by giving them their plain meaning, neither Perlin nor Kees teach or suggest a surgical ligation clip formed of a single piece of material having a first free end and a second free end terminating proximate the proximal end thereof as recited in independent claim 12. Accordingly, given the disclosure of Perlin and Kees, Applicant submits that a combination thereof does not result in the surgical ligation clip recited in independent claim 12. As such, independent claim 12 is patentable over the Examiner's rejection under 35 U.S.C. § 103(a). Therefore, the Examiner's rejections of claims 24 and 32-34 are rendered moot at least because these claims dependent from allowable independent claim 12.

In conclusion, Applicant submits that amended independent claims 1 and 12 are patentable and that dependent claims 2-11, 13-24, and 27-34 dependent from independent claims 1 or 12, or claims dependent therefrom, are patentable at least due to their dependency from an allowable independent claim.

Applicant respectfully requests that this Amendment under 37 C.F.R. § 1.116 be entered by the Examiner, placing claims 1-24 and 27-34 in condition for allowance. Applicant submits that the proposed amendments of claims 1 and 12 do not raise new issues or necessitate the undertaking of any additional search of the art by the Examiner, since all of the elements and their relationships claimed were either earlier claimed or inherent in the claims as examined. Therefore, this Amendment should allow for immediate action by the Examiner.

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Furthermore, Applicant respectfully points out that the final action by the Examiner presented some new arguments as to the application of the art against Applicant's invention. It is respectfully submitted that the entering of the Amendment would allow the Applicant to reply to the final rejections and place the application in condition for allowance.

Finally, Applicant submits that the entry of the amendment would place the application in better form for appeal, should the Examiner dispute the patentability of the pending claims.

In view of the foregoing remarks, Applicant submits that the claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the entry of this Amendment, the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

To the extent any extension of time under 37 C.F.R. § 1.136 is required to obtain entry of this reply, such extension is hereby respectfully requested. If there are any fees due under 37 C.F.R. §§ 1.16 or 1.17 which are not enclosed herewith, including any fees required for an extension of time under 37 C.F.R. § 1.136, please charge such fees to our Deposit Account No. 50-1068.

Respectfully submitted,

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